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10/803,856

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Jeffrey S. Poulin

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EXAMINER

ERB, NATHAN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,856	Applicant(s) POULIN, JEFFREY S.	
	Examiner NATHAN ERB	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant's response to Office action was received on November 14, 2007.
3. In response to applicant's amendment of the claims, the corresponding claim rejections below in this Office action have been correspondingly amended.
4. Examiner believes that the amendments to the rejections below in this Office action render applicant's arguments to be no longer applicable.

Claim Rejections - 35 USC § 103

5. Claims 1-9, 11-19, and 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly et al., U.S. Patent No. 6,459,953 B1, in view of Pintsov et al., U.S. Patent No. 6,775,590 B2.

As per **Claims 1, 11, and 21**, Connelly et al. discloses:

- a method of processing business reply mail using a sorting apparatus, comprising acts (column 1, lines 4-9; column 3, lines 21-41; column 3, line 57, through column 4, line 3; column 6, lines 7-54; column 8, lines 9-21; sorts business reply mail pieces among various output bins);
- receiving (or at least one feeder unit that receives) a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece (column 3, lines 21-40; column 8, lines 9-21; reference states in column 3, lines 21-24, that the input stream may include both "business reply cards" and "post cards;" "post cards" would include non-

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business reply mail pieces; also, the postal facility embodiment of column 8, lines 9-21, would include an input stream of both business-reply and non-business reply mail pieces because postal facilities process both types of mail from a mixed input stream);

- automatically identifying the at least one business reply mail piece in the stream of mail pieces (column 3, lines 21-41; column 3, line 57, through column 4, line 3; column 6, lines 7-54; column 8, lines 9-21; if the system is able to sort business-reply mail pieces among various bins, meant for various types of business-reply mail pieces, it must inherently be able to identify that a mail piece is a business reply mail piece; also, the postal facility embodiment would have an input stream of both business-reply and non-business reply mail pieces, so at some point, the two types of mail would have to be differentiated from each other so that the business-reply mail pieces could be processed in the intended way for that type of mail);

- determining that the at least one business reply mail piece is a business reply mail piece and not a non-business reply mail piece (column 3, lines 21-41; column 3, line 57, through column 4, line 3; column 6, lines 7-54; column 8, lines 9-21; the postal facility embodiment would have an input stream of both business-reply and non-business reply mail pieces, so at some point, the two types of mail would have to be differentiated from each other so that the business-reply mail pieces could be processed in the intended way for that type of mail);

- reading human-readable text from business-reply mail pieces using optical character recognition techniques (column 5, line 21, through column 6, line 6; column 6, lines 7-54; OCR is used to read human-readable text);

- at least one computer readable medium encoded with instructions that, when executed on a computer system perform a method of processing business reply mail, the method

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comprising acts (column 1, lines 4-9; column 4, lines 4-21; instructions would have to be stored on some sort of computer readable medium);

- a sorting apparatus (column 3, line 57, through column 4, line 3; column 6, lines 7-54; sorts business reply mail pieces among various output bins);
- at least one controller (column 4, lines 4-21).

Connelly et al. fails to disclose, in response to the act of determining that the at least one business reply mail piece is a business reply mail piece, automatically reading information on the at least one business reply mail piece while the at least one business reply mail piece is in the stream of mail pieces. Pintsov et al. discloses, in response to the act of determining that the at least one business reply mail piece is a business reply mail piece, automatically reading information on the at least one business reply mail piece while the at least one business reply mail piece is in the stream of mail pieces (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52; apparatus may be integrated into a facer/canceller system which can separate out business reply mail and courtesy reply mail, as opposed to the apparatus receiving a stream of only business reply mail and courtesy reply mail from an upstream facer/canceller system; where the apparatus is integrated into the facer/canceller system, the input stream of mail pieces can contain both business reply and non-business reply mail pieces; the apparatus reads the MRCI on the mail piece). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. such that, in response to the act of determining that the at least one business reply mail piece is a business reply mail piece, it automatically reads information on the at least one business reply mail piece while the at least one business reply mail piece is in the

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stream of mail pieces, as disclosed by Pintsov et al. Motivation is provided by Pintsov et al. in that such a configuration of Pintsov et al.'s invention does not require pre-sorting of business-reply and non-business reply mail pieces (column 3, line 26, through column 4, line 28; column 8, lines 10-45; column 9, lines 4-36; column 9, lines 37-52).

As per **Claims 2, 12, and 22**, Connelly et al. further discloses wherein the act of automatically identifying the business reply mail piece further comprises an act of: distinguishing (or wherein the at least one controller distinguishes) the at least one business reply mail piece from the at least one non-business reply mail piece (column 3, lines 21-41; column 3, line 57, through column 4, line 3; column 4, lines 4-21; column 6, lines 7-54; column 8, lines 9-21; the postal facility embodiment would have an input stream of both business-reply and non-business reply mail pieces, so at some point, the two types of mail would have to be differentiated from each other so that the business-reply mail pieces could be processed in the intended way for that type of mail).

As per **Claims 3, 13, and 23**, Connelly et al. further discloses wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of: capturing (or wherein the sorting apparatus includes at least one camera that captures) at least one image of the at least one business reply mail piece; and processing (or wherein the at least one controller processes) the at least one image to convert the information on the at least one business reply mail piece into electronic form (column 3, lines 41-56; column 3, line 57,

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through column 4, line 3; column 4, lines 4-21; column 5, line 21, through column 6, line 6; column 6, lines 7-54).

As for **Claims 4, 14, and 24**, Connelly et al. further discloses wherein the act of automatically reading information on the at least one business reply mail piece further comprises an act of: reading (or wherein the sorting apparatus further comprises a barcode reader that reads) a barcode on the at least one business reply mail piece (column 3, line 57, through column 4, line 3; column 4, lines 22-51; column 5, line 21, through column 6, line 6; column 6, lines 7-54).

As per **Claims 5 and 15**, Connelly et al. further discloses wherein the at least one business reply mail piece is addressed to an intended recipient and the method further comprises an act of: not delivering the at least one business reply piece to the intended recipient (Figure 2A; column 8, lines 9-21). Connelly et al. fails to disclose discarding the at least one business reply mail piece. Pintsov et al. further discloses discarding the at least one business reply mail piece (column 12, lines 36-52). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. as modified in the rejection for claims 1 and 11 such that it discards the at least one business reply mail piece, as disclosed by Pintsov et al. Motivation is provided by Pintsov et al. in that discarding the mail piece allows it to be recycled (column 12, lines 36-52).

As per **Claims 6, 16, and 26**, Connelly et al. further discloses an act of: storing (or wherein the at least one controller stores) the information in electronic form (column 4, lines 4-21; column 5, line 21, through column 6, line 6; column 6, lines 7-54).

As per **Claims 7, 17, and 27**, Connelly et al. further discloses wherein the business reply mail piece is associated with an originating entity and the method further comprises an act of: receiving the information at (or the at least one controller sends the information to) the originating entity (column 4, lines 4-21; column 8, lines 9-21).

As per **Claims 8, 18, and 28**, Connelly et al. fails to disclose wherein the act of sending the information to the originating entity further comprises an act of sending (or wherein the at least one controller sends) the information to the originating entity in electronic form. Pintsov et al. further discloses wherein the act of sending the information to the originating entity further comprises an act of sending (or wherein the at least one controller sends) the information to the originating entity in electronic form (Figure 4; column 11, line 60, through column 12, line 27). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. as modified in the rejection for claims 7, 17, and 27 such that the act of sending the information to the originating entity further comprises an act of sending (or the at least one controller sends) the information to the originating entity in electronic form, as disclosed by Pintsov et al. Motivation is provided by Pintsov et al. in that electronic transmission of the information allows for reduced processing time of the mail pieces (column 10, lines 18-65).

As per **Claims 9, 19, and 30**, Connelly et al. further discloses wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility (column 3, lines 21-40; column 3, line 57, through column 4, line 3; column 5, line 21, through column 6, line 6; column 6, lines 7-54; column 8, lines 9-21).

As per **Claim 25**, Connelly et al. further discloses wherein the sorting apparatus further comprises at least one output bin that receives mail pieces, and wherein the at least one controller routes the at least one business reply mail piece to the at least one output bin (column 3, line 57, through column 4, line 3; column 4, lines 4-21; column 6, lines 7-54). Connelly et al. fails to disclose discarding the at least one business reply mail piece. Pintsov et al. further discloses discarding the at least one business reply mail piece (column 12, lines 36-52). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. as modified in the rejection for claim 21 such that it discards the at least one business reply mail piece, as disclosed by Pintsov et al. Motivation is provided by Pintsov et al. in that discarding the mail piece allows it to be recycled (column 12, lines 36-52).

As per **Claim 29**, Connelly et al. further discloses wherein the business reply mail piece is associated with an originating entity (column 8, lines 9-21). Connelly et al. fails to disclose wherein the at least one controller receives a request for the information from the originating entity. Pintsov further discloses wherein the at least one controller receives a request for the information from the originating entity (Figure 4; column 6, lines 33-67; column 11, line 60,

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through column 12, line 27). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. as modified in the rejection for claim 21 such that the at least one controller receives a request for the information from the originating entity, as disclosed by Pintsov et al. Motivation is provided in that such a request allows the originating entity to obtain the information from the business reply mail processing system (Figure 4; column 6, lines 33-67; column 11, line 60, through column 12, line 27).

As per **Claim 31**, Connelly et al. further discloses wherein the information includes an address of an initial recipient of the business reply mail piece (column 4, line 52, through column 5, line 7).

6. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly et al. in view of Pintsov et al. in further view of Gleckman, U.S. Patent Application Publication No. US 2004/0215472 A1.

As per **Claims 10 and 20**, Connelly et al. further discloses wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of: identifying the request for additional materials; and in response to identifying the request, sending the additional materials to the sender (column 1, lines 12-22; column 4, line 52, through column 5, line 7; column 5, line 21, through column 6, line 6). Connelly et al. and Pintsov et al. fail to disclose using a mail processing facility as a fulfillment center. Gleckman discloses using a mail

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processing facility as a fulfillment center (paragraph [0013]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Connelly et al. as modified in the rejection for claims 9 and 19 such that it uses a mail processing facility as a fulfillment center, as disclosed by Gleckman. Motivation is provided by Gleckman in that doing so provides a service to organizations that wish to outsource such functions (paragraph [0013]).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that

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the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN ERB whose telephone number is (571)272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb
Examiner
Art Unit 3628

Nhe

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Supervisory Patent Examiner, Art Unit 3628